

United States Circuit Court of Appeals

FOR THE NINTH CIRCUIT

PORTERVILLE CITRUS ASSO-	}
CIATION, a corporation,	
<i>Appellant,</i>	
vs.	
FRED STEBLER,	}
<i>Appellee,</i>	

APPELLANT'S REPLY BRIEF

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III.

IN THE
United States Circuit Court of Appeals
FOR THE NINTH CIRCUIT

PORTERVILLE CITRUS ASSO- CIATION, a corporation,	ir	}	
	<i>Appellant,</i>		
vs.			
FRED STEBLER,	<i>Appellee,</i>	}	In Equity No. 2960

and

MID-CALIFORNIA CITRUS ASSO- CIATION, a corporation,	ir	}	
	<i>Appellant,</i>		
vs.			
FRED STEBLER,	<i>Appellee.</i>	}	In Equity No. 2961

APPELLANTS' REPLY BRIEF

At the hearing of the above appeals, appellees were granted fifteen days for the filing of brief, and permission was given appellants to file a reply brief should it be deemed advisable so to do. We

believe the brief filed by appellees demands a reply, in order that the Court may not be misled by certain portions thereof and further that certain statements contained therein may not pass unchallenged.

The first six pages of appellee's brief appears to be directed to the fact that inasmuch as the trial Judge saw the machine in operation, this Court should not disturb the decision of the lower Court, contending that this Court has not before it all of the evidence. Such contention is not sound, and in asserting this, counsel for appellees overlooks the fact that the trial Judge necessarily based infringement on the construction given him to the claims of the letters patent alleged to have been infringed, and in so doing gave to the claims the construction contended for in the lower Court and here asserted, viz, that the Stebler patented device discloses a generic invention. If the record discloses the invention to be a non-generic one, a mere improvement over the devices of the prior art, then the argument advanced by appellee in the lower Court and urged on this appeal is unsound. Appellee overlooks the fact that this is an appeal in equity and on such the hearing in the Appellate Court is a hearing *de novo*. If the argument advanced by appellee be sound in law, it is only required that the trial Judge be induced to inspect an alleged infringing machine in operation in order to defeat the right to contest by appeal the corrections of the decision of the lower Court, by contending in the Appellate Court that the lower Court "did not adjudge the issue solely upon the transcript of record

filed in this Court.” However, we have presented to this Court all that was before the trial Judge, for there has been produced the Exhibit of appellee’s patented structure and we have reproduced by model the appellants machine held to be an infringement.

There is also before the Court model of the Miller machine held to be an infringement of the Stebler patented distributing system in the case of Stebler vs. Pioneer Fruit Company. This model of the machine held to be an infringement in said suit is substantially a counterpart of the Stebler patented apparatus so far as relates to the distributing means comprising the conveyor belt and the transversely disposed guide means constituting the chutes for directing the sized fruit to the fruit receiving bins, excepting as to the adjustable end section of the guides. In the Stebler device the adjustable end 12 of each guide is telescopic relative to the body member 13 of the guide, whereas in the Miller device the outer end of each guide is hinged to its body section. Otherwise the distributing means correspond, and an inspection of said model and comparison thereof with the Stebler patent enables one to understand the construction and operation of appellee’s apparatus. As a further aid to the Court, we presented in our opening brief, opposite page 76 thereof, a cut of the appellants machine.

In the brief filed, appellee does not deny the correctness of either the model of appellants machine or the above mentioned cut illustrative of the said

machine, nor could he well do so, inasmuch as they correctly illustrate the held infringed apparatus.

The Court thus has all that was before the trial Judge.

Appellee seemingly relies on the case of the Central California Canneries Company vs. Dunkley Company, recently decided by this Court, as sustaining his position. The pertinency of said decided case is not apparent. There it was admitted that the defendant's machine fell within the claim of the Letters Patent, and in fact was the same device, leaving the only question to be determined by the lower Court whether patentee Dunkley was the inventor of the patented structure. The testimony presented on this phase of the case was conflicting and it is the writer's understanding the testimony of the principal witness produced by the defendants was discredited by the trial judge.

In the present case, there is no admission that appellants' machine is the same as the Stebler patented structure, even if the claims thereof are valid, nor is there conflicting testimony as to the appellants' machine working in the manner set forth in our opening brief. The only possible conflict of testimony being whether or not the longitudinally adjustable barriers at times utilized in connection with appellants' machine, constitute guide chutes of the kind and character of the Stebler patented structure. To determine this question, requires that the claims of the letters patent be construed not only in the light of the prior art as it existed at the date of the alleged invention, but

equally so in the light of the disclosure of the Letters Patent themselves.

From a reading of the specification of the Letters Patent with the drawings thereof, it is apparent that the gist of appellee's patent resides in provision being made for the utilization of a comparative short grader or sizer in conjunction with a distributing system and bins extended a distance beyond the longitudinal extension of the grader or sizer member, the distributing system comprising the endless longitudinal traveling conveyor and the elements 12 and 13, the latter being arranged transversely relative to the conveyor and forming downwardly inclined chutes or guides for leading the sized fruit from the discharge outlets of the grader or sizer member to the point of discharge into bins to receive such fruit. These guides or chutes are pivoted adjacent the respective discharge outlets of the grader or sizer member and are of such a character that the sized fruit from one of the discharge outlets may be directed to a point of discharge beyond a succeeding discharge outlet of the grader or sizer member, and this without the two streams of discharged sized fruit becoming intermixed. In carrying out the invention of the Stebler patent, the fruit receiving bins are required to be projected beyond the longitudinal extension of the grader or sizer member, and of necessity the distributing means employed must be of such a character that the stream of sized fruit discharging from one discharge outlet may be carried beyond the next discharge outlet of the grader or sizer

member without an intermingling of the sized fruit. In appellants' machine the sized fruit discharging from one discharge outlet of the grader or sizer member cannot be carried beyond the next discharge outlet without causing an intermingling of the sized fruit. This is due to two causes, first, the fruit receiving bins and the longitudinally movable carrier are not extended beyond the longitudinal extension of the grader or sizer member within the intent and spirit of the Stebler invention, and second, no chutes or guides are employed for leading the fruit from the respective discharge outlets of the grader or sizer member transversely of the longitudinally movable carrier to bins extended beyond the discharge outlets for the reception of the sized fruit, the sized fruit under the Stebler invention being under the control of the chutes or guides from the moment of leaving the discharge outlets for the sized fruit until delivered into the bins for the reception thereof.

In the use of the longitudinal disposed barrier pieces employed at times during the operation of the appellants machines and when so employed arranged parallel with the endless traveling conveyor and adjacent one or more of the fruit receiving bins, the sized fruit discharging or escaping from one discharge outlet of the grader member cannot be carried beyond a succeeding discharge outlet for the sized fruit without causing an intermixing of the two sizes of sized fruit, which would necessitate a re-sizing of the sized fruit in order to maintain the integrity of the sizes. This we illustrated to the

Court on argument by reference to the model of appellants machine. Counsel for appellee combated the statement and undertook to prove that our statement was incorrect, but he was unable to demonstrate the incorrectness of our position.

We denied on the hearing of this appeal the correctness of the photographs used by counsel for appellee to illustrate that the sized fruit escaping from one discharge outlet of the grader member could be carried beyond a succeeding discharge outlet without causing an intermingling of the escaping sized fruit, and there is nothing contained in appellee's brief which disproved our statement. These photographs are deceiving, to the same extent as Photo Ex. 5, Record p. 538.

In appellee's apparatus the intent is to carry fruit discharging from one discharge outlet of the grader member beyond a succeeding discharge outlet without causing an intermixing of the two sizes of the discharging sized fruit, and such is necessary in order that his invention may be utilized in connection with a short grader member, i. e. the distributing means and its associated fruit receiving bins extended a distance beyond the longitudinal extension of the grader member. Appellant's machine is so designed that the fruit discharging from one discharge outlet of the grader member cannot be carried beyond a succeeding discharge outlet and the integrity of the sizes be maintained.

The construction and operation of the Stebler patented apparatus and equally so the construction and operation of the appellants invention has been

fully considered and treated in our opening brief, and further consideration need not be given thereto, it sufficing to state that our statement as to the construction and operation of the two machines is fully stated and borne out by the testimony of the witnesses, and we are satisfied that we have properly construed the machines, and further that the cuts appearing opposite pages 16 and 76 of our opening brief correctly represent the appellee's patented distributing system and the operation thereof and the construction and operation of the appellants' machine.

On page 7 of appellees' brief there is a slight criticism made as to the lack of care with which the appellants proceeded in the perfecting of the appeal herein. Criticism is made to our sixth assignment of error, holding that the same has not foundation therefor in the decree. This is an immaterial error, but inasmuch as a reference to a Master for an accounting of profits and damages usually appears in an interlocutory decree, it was taken for granted that the same would be embodied in the decree appealed from herein, and as the appeal papers were prepared prior to the submission of the proposed decree to counsel, and in fact, the appeal papers filed with the Court on the same day the interlocutory decree was signed and filed, the fact that the decree did not provide for a reference to the Master was overlooked.

On the same page, counsel for appellee states, that this carelessness on the part of the appellant is reiterated by the eighth assignment of error,

which assignment of error alleges that the lower Court erred in holding the appellants had infringed Re-issue Letters Patent No. 12,297 and particularly Claims 1 and 10 thereof. We do not understand this criticism of counsel, inasmuch as the interlocutory decree adjudged that Re-issue Letters Patent No. 12,297 were good and valid and "that defendant has infringed upon said Re-issue Letters Patent 12,297, particularly as to Claims 1 and 10 thereof." The eighth assignment of error is directed to this error of the lower Court. We did not challenge the decree holding the Re-issue Letters Patent to be valid, nor could we well do so, in view of the fact that heretofore this Court had held the Letters Patent and more particularly Claims 1 and 10 thereof to be valid, but by our assignment of error, we do challenge the correctness of the lower Court in holding the said Letters Patent and Claims 1 and 10 thereof to have been infringed, and which is embodied in paragraph 4 of the interlocutory decree. Why we are not in a position to assert this eighth assignment of error, we are at a loss to understand, more particularly so as this Court held in Appeal Case No. 2722, that Parker Modified type of fruit grader or sizer did not constitute an infringement of the said Re-issue Letters Patent and more particularly Claims 1 and 10 thereof.

As we pointed out in our opening brief, while the decision of the trial Court did not hold infringement of the said Robert Strain Re-issue Letters Patent, nevertheless, the decree so holds, and it is

from this portion of the decree that the eighth assignment of error is directed.

Counsel for the appellees states that we are in no position to assert this eighth assignment of error, but the facts as contended for by counsel in support of such contention is not a correct statement. No stipulation was ever entered into as contended for by counsel on pages 7, 8, 9 and 10 of his brief, and the outlining of the proceedings which took place is not correctly given by counsel for appellees. What did happen and we are only too anxious that the Court have full knowledge thereof, although not contained in the Transcript of Record, is the following:

When the motion for a preliminary injunction came on for hearing, the trial Judge expressed a doubt as being able to understand the machinery from the photo exhibits submitted with the moving affidavits and from the ones embodied in the affidavits filed in opposition to the preliminary injunction. Counsel for defendants suggested that the Court examine the machines in order to determine whether or not there was any adjustment provided for in connection with the roller members of the Parker modified machines which would bring the same within the protection afforded by Claims 1 and 10 of the Strain Re-issue Letters Patent, and the Court consented and did make the trip to Porterville, California, for the purpose of examining the machine. When counsel for appellants understood that counsel for appellee contended for infringement by reason of the fact that in his opinion

the brackets could be adjusted (although such was not the case), counsel for appellants stated, if such constituted the only claim for infringement, that rather than go to the expense of prolonged litigation, the appellants would consent that an injunction might issue against an adjustment of any kind being made to said brackets after the machine had been installed and placed into operation. This was not accepted by counsel for appellees and he insisted on going to full hearing as to whether or not the Parker Modified Machine constituted an infringement of Claims 1 and 10 of the Strain Re-issue Letters Patent. No stipulation therefor was ever entered into and it will be noted by reference to the matter quoted on page 8 of appellees' brief, that statement was made to the Court that consent was given at Porterville (at least 6 months prior to final hearing) that an injunction might be issued against adjusting the roller section, but it will be noted, by such quoted matter, that Mr. Lyon, attorney for appellee, was not satisfied for a mere injunction against an adjustment of the brackets, for he stated, "Well, I do not care whether they remove it or not," meaning, that it was immaterial so far as going to the question of infringement. By the insistence of counsel for appellees to try the question on its merits at a later date, at Los Angeles, rather than to accept what was offered him six or seven months prior at Porterville, he placed the appellants to more than half of the expense of the testimony taken in the lower Court as to non-infringement of the Strain Re-issue Letters Patent,

and more than one-half of the expenses incident to the present Transcript of Appeal, and he now complains that we have no right to contest the correctness of a decree, holding infringement of that which the lower Court in its decision held not to be an infringement and which this Court has held not to be an infringement. Certainly, if the trial Judge held non-infringement, counsel for appellee had no right to provide for infringement in the decree as prepared by him.

As stated on page 9 of the brief, it is true that a copy of the decree as prepared was served upon counsel for appellants, but as the same was prepared and appeared to be in accordance with that which had before been transmitted by counsel for appellees to counsel for appellants as constituting the decision of the Court, no objection could be taken to the form of the decree.

It is not correct to state that neither complainant or defendant have any real interest in the question covered by our eighth assignment of error. The appellants are deeply interested in this eighth assignment of error, and it is not immaterial whether this portion of the decree be abrogated, but, on the contrary, decidedly material to the appellants, inasmuch as they have a right to a reversal of a decree holding infringement of that which has heretofore held by this Court to be a non-infringing structure. At no time did defendant consent that a decree could be entered holding infringement of the Strain Re-issue Letters Patent, and the only consent given at all was long prior to the final hearing of this

case, and simply that an injunction could be issued against adjusting the brackets and this solely in order to avoid the expense of litigation attending the final hearing.

As stated, counsel for appellees refused to accept such consent and insisted upon placing appellees to the heavy expense of going to full proof on final hearing, admitting on argument of this appeal that the sizer employed by the appellants, and decreed to be an infringement, did not infringe the Robert Strain reissue Letters Patent.

Page 11 of the brief does not correctly set forth the statement of counsel for appellants. Our statement was, that the Transcript of Record in this case disclosed that the Stebler invention as placed on the market, was in conjunction with a sizer or grader of a length much less than that of the distributing system and the bins, and in this, we are supported by the testimony in the case, and which we have referred to in our opening brief.

Between pages 14 and 22 of appellees' brief, it is insisted that the adjustability of the bin space constitutes an essential feature of the Stebler invention. If such is the case, it is a significant fact that patentee Stebler failed to procure a claim for this feature of the alleged invention, which at this time only becomes of importance in an endeavor by the appellee to take the Stebler invention from within the disclosure of the Thomas Strain Patent No. 775,015, Record page 525, complainant's Exhibit No. 3, or the Beekhuis Patent No. 906,605, defendant's Exhibit, Record page 99. Either of these pat-

ented structures contain each and every element of the Stebler patented distributing system as the scope therefor is contended for by counsel for appellees, excepting the adjustability of the bin space. However, it will be remembered that at a much earlier period in the art the adjustable bins or adjustable bin spaces for the fruit were in common use, being illustrated in Photo Exhibits "O," "P" and "P'", of the Camel-back machine, Record pages 815, 817, 819, and testified to by witness Ofsted, as heretofore referred to in our opening brief. The adjustability of the bin spaces was therefore public property a great many years prior to the date of the alleged Stebler invention, and it did not constitute invention on the part of appellee Stebler to add to the fruit grading and distributing apparatus of the Thomas Strain patent, or of the Beekhuis patent, the adjustable bins of the prior art. In the Thomas Strain Patent No. 775,015, Record p. 528, no reference is made to the adjustability or non-adjustability of the fruit receiving bins, he simply illustrating proper bins for the reception of the fruit; the use of adjustable or non-adjustable bins being left to the option of the constructor thereof. The only purpose of providing adjustable bins is to accommodate a greater number of packers for the bins, and this was the purpose of the adjustability of the bins of the Camel-back machines of the prior art, and as such well known to the public generally, and more especially known to patentee Stebler, as he testified as to his knowledge of the Camel-back machines. Adjustable bins certainly would give no

greater accommodation to the packers for the fruit than the transversely traveling belts 12 of the Beekhuis patent, inasmuch as the belts could be extended or prolonged to any distance, and by so doing anywhere from two to twenty packers permitted to operate from any given belt. Therefore, we contend that the employment of the adjustable bins did not impart patentability to the structure of appellee, but that the patentable features, if any, must be found in some other feature or features of the apparatus, and can only be found in the specifically constructed chutes or guides arranged transversely of the traveling conveyor and inclined from the discharge outlets for the sized fruit toward the fruit receiving bins projecting a distance therebeyond. As heretofore pointed out, in the Beekhuis patent we have the grader or sizing member of less length than the longitudinally traveling conveyor. This conveyor travels over a supporting structure and the fruit received thereon from the grading member is conveyed longitudinally of the apparatus by said endless traveling conveyor 8, which is arranged parallel to and below the grader in the same manner as the endless conveyor of the Stebler patent is arranged. The sized fruit received onto the conveyor 8 is prevented from moving therefrom by reason of the barrier wall 9 upwardly projected from the table or supporting structure for the conveyor 8 and the fruit received onto the said conveyor is deflected or guided therefrom at an inclination by means of the guide barriers 11, pivoted to the supporting table over which the endless conveyor 8

works, and which pivoted guides or deflectors direct the sized fruit from the said conveyor 8 onto the fruit receiving members 12, through the outlet openings 10, in the barrier wall 9. The amount of sized fruit deflected onto the members 12 is dependent on the angularity of the members 11. By suitably arranging the members 11 all of the fruit received from one of the discharge apertures of the grader member may be directed onto its associated member 12 or only a portion thereof, dependent upon the position of the barrier 11. If so desired, the fruit received from one grade aperture may be carried to the next grade aperture and intermingled with the sized fruit therefrom and be deflected with such fruit onto the member 12 adapted to receive the fruit from such discharge outlets. In other words, every combination which is capable of being carried out by the Stebler distributing system, may be accomplished by the Beekhuis patented apparatus. It is immaterial whether the members 12, be laterally traveling belts or fruit receiving bins for the sized fruit, inasmuch as the constructor of the said apparatus had a perfect right to utilize in connection therewith the receiving means for the sized fruit of the prior art, and one form of such receiving means comprised adjustable bin members.

The construction now sought by counsel for appellee to be given the claims of the Stebler patent is such that if accepted, they are completely anticipated by the Thomas Strain patent or by the Beekhuis patent, and we believe by the Rayburn Patent No. 741,928, Record page 791. Rayburn was

familiar with the devices of the prior art and he sought as a substitute for the adjustable bins thereof, the fixed bins of large capacity, extended beyond the grader or sizing member and a given number of bins arranged at each side of the machine, or in other words, dividing the bin area between the two sides of the machine and thereby obtaining double the bin area of the ordinary series of bins placed at one side of the machine and not extended beyond the sizer or grader member, and the purpose of so doing was to accommodate a greater number of packers at the fruit receiving bins. In this manner Rayburn provided accommodations for a greater number of packers than could be provided without given adjustability to the fruit receiving bins.

Between pages 23 and 34 of brief, appellee insists that there was no cancellation of claims in the application of the Stebler invention, but that, on the contrary, applicant Stebler in the Patent Office contended and insisted on his claims. This is true to a certain extent, for he did contend and insist for the claims after the rejection and cancellation of the broad claims of the application, and the Board of Appeals allowed the claims of the Letters Patent based on the differentiation which was then made between the Stebler invention and the inventions of the prior art.

Particular attention is directed on page 32 of the brief to Claim 11 of the Stebler patent, and attention is called to the fact that it is not limited in any manner whatsoever to details of construction. This does not appear to be a correct statement, in view of

the fact that said Claim 11 is limited over rejected and cancelled Claim 8 set forth in full on page 50 of our opening brief, in the following respects: Rejected and cancelled Claim 8 covered broadly,

“ * * * said guide means being adjustable to shift the point of discharge longitudinally of the conveyor.”

Claim 11 brought into the claim the limitation that the guide means shall be adjustable to shift the longitudinal position of the outer ends, and when we read the specification, we find the only means capable of shifting the longitudinal position of the outer ends of the chutes or guide means to reside in the pivotal connection of the guide means with the extension represented by the letter “E” of sketch 3 opposite page 17 of our opening brief, and the adjustable end extension represented by the reference numeral 12, which is telescopic relative to its companion member 13 of the guide means. In fact, it is the telescopic member 12 of the guide means which permits the longitudinal position of the outer ends of the guide means to be adjusted relative to any adjustment of the bins. It makes no difference on what grounds the original claims were rejected, for if such rejection is acquiesced in, it is an admission that the claims were properly rejected, and the resultant claims cannot be construed to cover that which falls within the cancelled claims. Record, pages 580-581, show the original claims which were cancelled. Record, pages 586-587, show the amendments which were made to the amended claims filed and which of the amended claims were rejected and cancelled, so it does not appear to come with good

faith from counsel to now contend that no limitations were placed on the Stebler invention during the prosecution of the application while pending in the Patent Office, in view of the reasons given by the Board of Appeals for allowing the appealed claims over the devices of the prior art.

Persistently throughout appellee's brief, the statement is made, that appellants admit all of the involved claims of the Stebler patent are valid and have sought to show non-infringement solely due to the limitations which must be placed on the claims of the said patent. Counsel has evidently mis-read or mis-understood our brief and argument in this connection. On page 52 of our opening brief, we stated:

“to so construe the claims of the Letters Patent as to give thereto at this time the construction which counsel for appellee now seeks to have placed thereon, is equivalent to asking the Court to so construe the claims of the patent as to cover that which the Patent Office refused to allow and which was canceled from the application.”

On page 66 of said brief, is found the statement:

“We maintain, to preserve the validity of Claims 1, 2, 3, 5, 6, 7, 8, 9, 11, 14, 15 and 19, there must be placed on the elements thereof such a construction as will differentiate the same from the invention of the Thomas Strain patent, etc.”

Again, on page 91 of said brief, we made the statement:

“It is not our contention that Claims 1, 2, 3, 4, 5, 6, 7, 8, 11, 14, 15 and 19 are anticipated by the devices of the prior art when the said claims are properly construed, but we do most earnestly contend that if the interpretation urged for these claims by the appellee is to be given thereto, then the claims are anticipated by the devices of the prior art and more particularly by the invention of the Thomas Strain patent.”

Certainly, no play of the imagination can construe such language into an admission that the claims of the Stebler patent are valid. As a matter of fact, we believe the claims as construed by appellee, are absolutely anticipated by the prior art, in fact, by either the Thomas Strain patent, the Beekhuis patent or the Rayburn patent.

Pages 36 to 54 of appellee's brief is devoted mainly to an analysis of the patents of the prior art, but as we have given consideration to said prior art in our opening brief, and the application thereof to the claims of the Stebler patent, we see no reason to reply to such portion of the brief. The patents are before the Court and the Court is fully competent to pass on the structure of the devices set forth and properly apply the same.

If we understand the statement contained in the first paragraph of page 55 of appellee's brief, the appellants are free to use their devices provided the longitudinally *adjustable barriers* are not employed in connection therewith. If such is the case, it is an admission upon the part of appellee that an apparatus comprising the Parker modified grader or sizing member, the longitudinally traveling con-

veyor and the adjustable bins arranged alongside of the traveling conveyor, does not constitute an infringement of the Stebler patent and the use thereof is free and open to the appellants. However, if there be employed in connection with said admitted non-infringing apparatus the longitudinally adjustable barrier member 36B of the prior Thomas Strain patent or the pivoted barrier members 11 of the Beekhuis patent, or the deflecting gates of the fruit runways of the prior Camel-back machines, there springs into existence or is created an infringement of the Stebler patent. This appears to be an absurdity on its face, for if we are free to manufacture the appellants machine as illustrated in Fig. 1 of the cut appearing opposite page 76 of our opening brief, wherein the barrier boards are not illustrated and do so without an infringement of appellee Stebler's patent, the builder or constructor of such a machine has a right to utilize in connection therewith any device of the prior art for the purpose of carrying out the function of such prior device, and the sole function of the guide member 36-B of the Thomas Strain patent, the pivoted guide member 11 of the Beekhuis patent, is to regulate the point of discharge for the sized fruit relative to the bins or the member ultimately to receive such sized fruit (which in the Thomas Strain patent are the fruit receiving bins and in the Beekhuis patent the fruit receiving member 12), and as the only function of the occasionally used barrier boards of the appellant's machine is to regulate the point of discharge of the fruit relative to the fruit receiving bins, it is

apparent that the addition to or the use thereof with the machine of the appellants without the barrier boards, is simply the carrying out of the function of the member 36-B of the Thomas Strain, the members 11 of the Beekhuis and the gates within the chutes of the Camel-back machines, and, equally so, of the pivoted member 6 of the Rayburn patent, which member is utilized to regulate the position of the discharge of the fruit flowing from the chutes into the fruit receiving bins.

On page 61 appellee has presented a somewhat interesting statement termed "Comparative Analysis of Stebler Distributing Apparatus Patent, plaintiff's Exhibit 2."

This is interesting from several view points: In the first instance, it is somewhat indefinite and takes for granted much which is not correct. In the second place, it is of interest as illustrating very forcibly how any structural device alleged to be an infringement may be made readable on the claims of a patented apparatus, and finally, it is interesting as illustrating how a device constructed of the prior art may be construed as an infringement of the claims of a later patented structure.

The devices of the prior art, in the present case may be analyzed in the same manner and made to appear to be an infringement of appellee's patent, and, in fact, under the construction seriously urged by appellees for the claims of the Stebler patent, constitute an infringement of the said claims. If this is true, that by the application of the same analysis presented by counsel for appellee, the prior

devices are made an infringement of the claims of the Stebler patent, then, the said claims are invalid by the application of that rule of law which holds, "that a device which if later infringes, anticipates if earlier."

It is not necessary to apply the Beekhuis or the Rayburn or the Camel-back machine in the making of this comparison, but we shall confine ourselves in the main to the Thomas Strain patent, and show by the same comparative analysis of the Stebler Distributing apparatus patent, as appears on page 61 of appellee's brief, that the said earlier patented device falls within the claims of the Stebler patent, and if constructed at a later date would be an infringement of the claims thereof. If we are correct in this, then said Thomas Strain patent is a complete anticipation of the claims involved herein.

APPELLEE'S COMPARATIVE ANALYSIS OF STEBLER'S DISTRIBUTING PATENT OF 1909, PLAINTIFF'S EXHIBIT 2, AS AP- PLIED TO THE THOMAS STRAIN PAT- ENT OF 1904, PLAINTIFF'S EXHIBIT 3.

STEBLER PATENT OF 1909.

CLAIM 1.

(1) A fruit grading element constructed to deliver fruit at different longitudinal portions.

This is the grader and the claim does not embrace or require any adjustment of the grade-openings.

THOMAS STRAIN PATENT 1904.

The grader composed of the rotating rod 20 and the grading belt 10 whether any adjustment be possible of the grade-openings.

(2) Inclined traveling supporting and distributing "means," the inclined belt 10 and devices having the function of controlling the point of delivery as desired.

The inclined distributing belt 10 arranged below the grading rod 20 and the "guides or barriers" 36-36-B having the function of controlling the point of delivery as desired.

Treating appellee's analysis for the sake of comparison of devices to be correct, then, claim 1 is anticipated by the Thomas Strain patent, and therefore invalid. This comparison also applies to the Beekhuis patent of 1908. Record, p. 99.

CLAIM 2.

(1) A grading element (again note that adjustment of the grade-opening is not material).

The grading or separating mechanism regardless of adjustment.

(2) The distributing belt 10.

The distributing belt 10.

(3) "Guiding means" arranged along the belt,—the parts 12 or 12 and 13. Not limited to these parts connected to bars or studs 14 or to any inclined or transverse arrangement.

The barrier 36 and 36-B, the barrier 36-B may be adjusted on the belt 10 in any relative desired position for convenience and discharge and so described in patent.

(4) Bins arranged along the length of the belt 10 and at the sides thereof.

Fruit receiving bins arranged along the length of the belt 10 and at the sides thereof.

The invention of this claim is therefore met by the invention of Thomas Strain and is invalid in view thereof. If produced at a later date under appellee's construction of the claim, the Thomas Strain device would infringe. Being earlier in time, it anticipates. The same applies to the Beekhuis patented and previously used apparatus, the laterally

traveling belts 12, which receive the sized fruit from the distributing means, being considered to be the full equivalent of fruit receiving bins.

CLAIM 3.

(1) Grading element.

Exactly correspond, i. e., a grading element (20).

(2) A traveling conveyor extending longitudinally under said grading element.

The endless conveyor belt (10) extending longitudinally under the grading element (20).

(3) Bins whose longitudinal extension is greater than the extension of the grading element.

Bins whose longitudinal extension may be greater than the extension of the grading element.

(4) Guiding means having the function "to guide the fruit" to the bins.

Guiding means, i. e. the elements 36 and 36-B having the function of guiding the fruit to the bins.

In the Thomas Strain patent the endless conveyor 10 is extended beyond the grader, Fig. 3 of the drawings. The fruit receiving bins, Figs. 3 and 2 of the drawings, are illustrated alongside of the conveyor and presumably throughout the length thereof. The Beekhuis patent discloses a grading element, distributing belt and guides extended beyond the grader element, and the elements for receiving the sized fruit from the distributing means extended beyond the grader.

Given claim 3 the construction now contended for by appellee, the same is anticipated by either the Thomas Strain patent or the Beekhuis patent. Either device if manufactured and later in time to the Stebler invention, would infringe the claim

under the construction placed thereon by appellee. Being earlier in date, they anticipate.

CLAIM 5.

(1) A grading element.
(Adjustability of grade-openings not a factor of the claim).

A grading element composed of the rotary longitudinally disposed member 20.

(2) A distributing belt (the belt 10).

A distributing belt (the belt 10).

(3) Bins (note the claim does not specify any particularly constructed bin as set forth in appellee's analysis of the claim).

A series of bins arranged alongside the distributing belt. They are constructed as specified by appellee and the partitions may or not be made adjustable.

(4) Guiding means referred to in the preferred form of embodiment of the invention, as the parts 12, 13, which are suitably supported on suitable bars or studs 14.

Guiding means referred to in the preferred form of embodiment of the invention, as the parts 36 and 36-B which are suitably supported.

The same comparison holds as to the Beekhuis patented and previously used structure, the receiving members 12 being considered as the equivalent of the fruit receiving bins. The function is the same, viz: to give room for a number of workers for the sized fruit received onto each element 12, which is the only function for the adjustability of the bins and such adjustability old in the earlier used Camel-back machines. Record, pp. 815, 17 and 19. In these earlier Camel-back machines the adjustable bins extended beyond the grader or sizer member.

As construed by appellee, claim 5 is met by the prior art.

CLAIM 6.

(1) A grading element.

A grading element.

(2) A horizontally traveling conveyor inclined downwardly from the grading element.

A horizontally traveling conveyor 10 inclined downwardly from the grading element.

(3) Bins arranged below and along said conveyor.

Bins arranged below and along said conveyor.

(4) Guiding means arranged along the conveyor providing chutes for directing fruit to the bins.

Guiding means 36 and 36-B arranged along the conveyor providing chutes for directing fruit to the bins.

In the Beekhuis earlier patented and used apparatus, we find (1) a grading element, (2) a horizontally traveling conveyor 8, arranged below the grader, (3) receiving elements 12 the full equivalent of bins for receiving the sized fruit discharged from the conveyor, and (4) guiding means 11 and 9 arranged along the conveyor and providing chutes (under appellee's interpretation of a chute), for directing fruit from the conveyor onto the receiving elements 12.

As contended for by the appellees, claim 6 is met by the prior devices and anticipated.

CLAIM 8.

(1) A fruit grader of graduated rotary member and traveling belt type.

This is the Ish patented grader No. 458,422 or the Strain Re-issue patented grader No. 12,297 and is not patentable to appellee Stebler. Thomas Strain patent discloses the same grader, also the Rayburn patent.

(2) A traveling conveyor arranged under the grader (the belt 10).

A traveling conveyor arranged under the grader (the belt 10 of the Thomas Strain patent and the belt 8 of the Beekhuis patent).

(3) A series of bins along the conveyor.

A series of bins arranged along the conveyor in the Thomas Strain patent. In the Beekhuis patent a series of fruit receiving elements 12 arranged along the conveyor.

(4) Adjustable guiding means arranged along the conveyor and forming chutes, said guiding means being adjustable to shift the point of discharge longitudinally or lengthwise of the conveyor.

Adjustable guiding means 36 and 36-B of the Thomas Strain patent arranged along the conveyor forming chutes, said guiding means being adjustable to shift the point of discharge longitudinally and lengthwise of the conveyor. In the Beekhuis patent the guiding means are the pivoted directing barriers 11.

There is not a leavening feature to take claim 8 from within the devices of the prior art. It is met element for element by the Thomas Strain patent and the claim as contended for by appellee is anticipated.

CLAIM 11.

(1) A fruit grading element.

A fruit grading element.

(2) A series of bins provided with adjustable partitions.

A series of bins which may or may not be adjustable as desired. Adjustable bins being old in the art.

(3) A conveyor belt (10) traveling longitudinally between the grading elements and bins.

A conveyor belt (10) traveling longitudinally between the grading element and bins.

(4) Guiding means arranged along the conveyor and forming chutes, said guiding means being adjustable to shift the longitudinal position of their outer or delivery ends in accordance with the longitudinal position of the walls or adjustable partitions of the bins.

Guiding means 36 and 36-B arranged along the conveyor and forming chutes. The member 36-B being adjustable to vary the point of discharge relative to the bins.

It is thus seen that there is an exact correspondence between the combination of claim 11 as construed by appellee and the elements and the interrelation of the elements of the Thomas Strain patent, and the elements function the same. Full mechanical equivalency not only of the combination as a whole, but of each element. The claim is anticipated by the prior patented and used apparatus of Thomas Strain, equally so, by the prior patented and used apparatus of Beekhuis.

CLAIM 14.

(1) A grader element of graduated rotary member and endless belt type forming a grading way or chute.

The rotary wall member 20 and the endless traveling belt forming a grading way or chute.

(2) A series of bins.

A series of bins.

(3) The distributing belt (10).

The distributing belt (10).

(4) Guiding means arranged along the conveyor forming chutes to guide the fruit to said bins.

Guiding means 36 and 36-B arranged along the conveyor and forming chutes to guide the fruit to the fruit receiving bins.

The above claim is fully met in terms and is anticipated by the Thomas Strain patent of 1904.

CLAIM 15.

(1) A grader element of the graduated rotary member and endless belt type forming a grading way on chute.

A rotary member and a grading belt, forming the grading element of the Thomas Strain patent the full equivalent.

(2) A downwardly inclined belt extended longer than the grader.

The downwardly inclined belt 10 is extended longer than the grader.

(3) Suitable means on the belt for guiding the fruit to the bins.

The means 36 and 36-B on the belt guide the fruit to the bins. The member 36-B is adjustable and regulable at will and forms a barrier.

(4) A series of bins.

A series of bins.

It will be noted that the device of the Thomas Strain patent contains every element of the claim as the claim is analyzed by appellees, and therefore anticipates the same. The Beekhuis patent meets every element of the said claim, when treating the receiving elements 12 as the full equivalents of the fruit receiving bins.

CLAIM 19.

(1) A grading element.

A grading element.

(2) An inclined distributing belt (10).

An inclined distributing belt (10).

(3) Guiding means arranged along the belt (10) and forming chutes for directing the fruit.

Guiding means 36 and 36-B along the belt and forming chutes for directing the fruit.

(4) Bins arranged below and along the belt 10.

Bins arranged below and along the belt 10.

(5) The bins having movable partitions whereby the width of the bins may be adjustable.

The bins may or may not have movable partitions whereby the width of the bins may be adjusted. This feature was old in the art and in common use in the Camel-back machine and the use thereof free to the constructor of the Thomas Strain patented apparatus.

In our opening brief we pointed out such limitations as we believed required to be given to the claims of the Stebler patent to differentiate the

same from the prior art, but we do not admit that such amounts to invention nor that when so construed the claims are valid. However, when so construed the appellants device does not fall within the claims and cannot be held to infringe thereof. It is for such reason that appellee urges strongly for a broad construction of the claims, overlooking the fact that any such construction of the claims brings the alleged invention within the prior art to such an extent as to render an apparatus constructed in accordance with the Thomas Strain patent an infringement thereof.

The only change made by appellee over the Thomas Strain apparatus, is one of form. A different form of guide means is employed, but the function of guiding the fruit is the same. He has utilized the adjustable bins of the prior art, but patentee Thomas Strain has not limited the invention to non-adjustable bins. Even had he done so, the public has the right to utilize such old form of bins with the Thomas Strain apparatus.

The changed form of guide means and the utilization of the old adjustable bins performs no new function in the Stebler invention over the devices of the prior art, unless the added function be such as to confine the invention to means whereby a short grader or sizer member is employed with a conveyor belt, distributing means and bins extended a considerable distance beyond the longitudinal extension of the grader or sizer member. When so construed, the appellants machines are not infringements.

The only difference pointed out by appellee for the Stebler invention over the Thomas Strain patent or the Beekhuis patent, resides in the employment of adjustable fruit receiving bins. However, the adjustability of the bins is only called for by claims 11 and 19. The other claims held to have been infringed make no mention of adjustable bins.

In appellee's machine the grader or sizer member is the same as that disclosed by the Ish, the Rayburn, the Robert Strain or the Thomas Strain patents of the prior art, and performs the same function.

The endless conveyor is the same as that of the Thomas Strain and of the Beekhuis patents and performs the same function.

The fruit receiving bins perform the same function as the fruit receiving bins of the Thomas Strain patent, the bins of the Camel-back machines, the bins of the Rayburn patent and the receiving members 12 of the Beekhuis patent.

The guide means perform no function over the guide means of the Thomas Strain patent, the guide means of the Beekhuis patent, or the guide means of the Camel-back machines and the machine of the Rayburn patent, unless the claimed added function resides in the utilization of a short grader or sizer in conjunction with distributing means and bins extended a considerable distance beyond the longitudinal extension of the grader or sizer and the further fact that the guide means are so constructed and extended as to form guide chutes extended from the discharge outlets of the grader or

sizer and transversely of the conveyor in order to guide the discharging sized fruits to bins extended a distance beyond the longitudinal extension of the grader or sizer.

Mere changes in form, composition, or construction of parts of a device, or some of the elements of an old combination will not constitute invention to sustain a patent, where the principle or mode of operation of the older devices are taken and the changed form is neither a distinguishing characteristic of the alleged invention nor material to the device or combination or its operation.

Under the construction which appellee gives to the claims of the Stebler invention in order to have the appellant held as an infringer, the alleged invention is brought within the prior art. The construction asked for, differs materially from the invention as defined by the Board of Appeals in the Patent Office when granting an allowance of the claims.

The Thomas Strain, the Beekhuis and the Stebler machines do their work in substantially the same way and for the accomplishment of same results, as the invention is contended for by counsel for appellee.

“If two devices do the same work in substantially the same way, and accomplish the same result, they are the same, even though they differ in name, form or shape. (Machine Co. vs. Murphy, 97 N. S. 125.)”

We believe under argument advanced by appellee for the Stebler invention, that the claims are either

completely anticipated by the prior art or they are invalid as mere aggregations, due to the fact that the respective elements perform the same function in the combination claims, as they do in the devices of the prior art.

We respectfully submit that the appellants' machine differs to a greater extent from the alleged invention of the Stebler patent, than appellee's said device differs from the prior art.

Respectfully,

NICHOLAS A. ACKER,
Solicitor and Counsel for Appellants.